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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,883	06/29/2001	Michael Joseph Calderaro	AUS9-2001-0238-US1	7241
40412	7590	07/01/2005	EXAMINER	
IBM CORPORATION- AUSTIN (JVL)			STIMPAK, JOHNNA	
C/O VAN LEEUWEN & VAN LEEUWEN			ART UNIT	PAPER NUMBER
PO BOX 90609				3623
AUSTIN, TX 78709-0609				

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/895,883	CALDERARO ET AL.	
	Examiner	Art Unit	
	Johnna R. Stimpak	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 June 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-20 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 29 June 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/8/04 3/8/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input checked="" type="checkbox"/> Other: <u>1449 6/29/01</u> . |

DETAILED ACTION

1. The following is a first office action upon examination of application number 09/895,883.

Claims 1-20 are pending and have been examined on the merits discussed below.

Claim Rejections - 35 USC §101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

3. Claims 1-7 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, the recited steps of receiving evaluation data and planning factor data, combining and storing does not apply, involve, use, or advance the technological arts since all of

the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to collect and store data concerning an employee.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the recited steps collect evaluation and planning factor data and store it (useful, concrete and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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5. Claims 1-20 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Paizis, US 6,338,042.

As per claim 1, Paizis teaches receiving evaluation data pertaining to the employee from each of the managers (column 5, lines 49-59 – evaluation data is received); calculating a combined evaluation for the employee from the received evaluation data (column 5, line 49 – column 6, line 10 – a performance evaluation is used to calculate a competency score); receiving planning factors data pertaining to the employee from each of the managers (column 5, lines 25-33 – for each individual a target pay level or payment schedule is received which is used along with the measure competency to determine the pay level); calculating a combined planning factors for the employee from the received planning factors data (column 5, lines 25-33 – for each individual a target pay level or payment schedule is received which is used along with the measure competency to determine the pay level); and storing the combined evaluation and the combined planning factors in an employee profile data area corresponding to the employee (fig 4 and 5A and column 9, lines 7-53 – a file is stored containing employee information including salary data and evaluation data).

As per claim 2, Paizis teaches storing the evaluation data and the planning factors data in the employee profile data area (fig 4 and 5A and column 9, lines 7-53 – a file is stored containing employee information including salary data and evaluation data).

As per claim 3, Paizis teaches at least one of the planning factors is selected from the group consisting of salary planning data, stock option planning data, award planning data, and promotion planning data (column 5, lines 25-33 – for each individual a target pay level or

payment schedule (salary data) is received which is used along with the measure competency to determine the pay level).

As per claim 4, Paizis teaches identifying an allocation percentage for each of the managers, the allocation percentage indicating an allocation of the employee to the manager; weighting the planning factor data received from each manager with the allocation percentage corresponding to each manager, wherein calculating the combined planning factors includes using the weighted planning factors; and weighting the evaluation data received from each manager with the allocation percentage corresponding to each manager, wherein calculating the combined evaluation includes using the weighted evaluation data (column 4, lines 42-58 and column 6, lines 1-15 – each employee position has different measures of competency and contribution level – for each combined score for the employee it is a sum of the scores which are weighted for each position held – inherently under different managers).

As per claim 5, Paizis teaches displaying the planning factors data provided by each of the managers on a plurality of display devices, wherein each display device corresponds to one of the managers (fig 4 and 5A and column 9, lines 7-53 – a file is stored containing employee information including salary data and evaluation data); receiving comments corresponding to the displayed planning factors data from at least one of the managers (column 9, lines 39-42 – a “notes” button is arranged such that annotations can be made regarding pay decisions); receiving a revision request from one of the managers corresponding to the planning factors data (column 7, lines 9-25 – user can input changes into the payment program); revising the planning factors data in response to the revision request (column 7, lines 16-25 – user inputs changes into the

payment program); and storing the revised planning factors data in the employee profile data area (column 7, lines 16-25 – changes to the payment program are stored).

As per claim 6, Paizis teaches recalculating the combined planning factors data in response to the revisions (column 7, lines 16-25 – once the payment program info is updated an the target pay for each individual is computed); and dynamically displaying the revised planning factors data on each of the display devices (column 7, lines 9-15 – once the target pay is computed it is then displayed).

As per claim 7, Paizis teaches displaying the evaluation data provided by each of the managers on a plurality of display devices, wherein each display device corresponds to one of the managers (fig 4 and 5A and column 9, lines 7-53 – a file is stored containing employee information including salary data and evaluation data); receiving comments corresponding to the displayed evaluation data from at least one of the managers (column 9, lines 39-42 – a “notes” button is arranged such that annotations can be made regarding pay decisions); receiving a revision request from one of the managers corresponding to the evaluation data (column 6, lines 23-33 – user can input changes concerning the evaluation data); revising the evaluation data in response to the revision request (column 6, lines 23-33 – the changes to the evaluation data are entered); and storing the revised evaluation data in the employee profile data area (column 6, lines 23-33 – and fig 5A – the changes are made and stored).

Claims 8-13 are the information handling system to perform the method of claims 1-5 and 7 therefore since Paizis teaches a system used to manage employee evaluation and pay data, the same rejections as applied to claims 1-5 and 7 are also applied to claims 8-13.

Claims 14-20 are the computer program product for performing the method of claims 1-7. Since Paizis teaches a computer software program for managing employee evaluation and pay data, the same rejections as applied to claims 1-7 are also applied to claims 14-20.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Richman, US 6,754,874 – computer-aided system and method for evaluating employees.

Tremaine, US 5,819,231 – compensation planning tool and method

Grimse et al, US 6,269,355 – automated process guidance system and method using knowledge management system

Zitaner et al, US 6,741,993 – competitive rewards benchmarking system and method

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Stimpak whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS
6/25/2005



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